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PCT. DT20 Rec'd PCT/PTO 18 APR 2003



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

ATTENTION: PCT LEGAL ADMINISTRATOR

In re Application of:) Conf. No.: 7001
Malcolm Lovell HANDEL et al)
Appln. No.: 10/068,471) Art Unit: 1646
Filed: February 4, 2002) Examiner: Not yet assigned
For: TREATMENT OF INFLAMMATORY) Washington, D.C.
AND MALIGNANT DISEASES) Atty. Docket: HANDEL=1
) April 18, 2003

**PETITION TO CONVERT A 35 U.S.C. 111 APPLICATION
TO A 35 U.S.C. 371 APPLICATION**

Honorable Commissioner for Patents
Washington, D.C. 20231

Sir:

The present petition is being filed pursuant to 37 C.F.R. §1.182 to convert a national application that was filed under 35 U.S.C. 111(a) to a national stage application filed under 35 U.S.C. 371.

STATEMENT OF THE FACTS

On August 4, 1999, Australian application PQ2014 was

filed. A year later, on August 4, 2000, an international

application was filed claiming priority of this Australian

application. The international application received

application no. PCT/AU00/00932. This application was

published as WO 01/11023. A copy of the first page of the

publication is attached as Exhibit A.

On February 19, 2001, a Demand for international preliminary examination was filed, and the U.S. was elected under the Demand. This caused the deadline date for entering the U.S. national phase to be extended through February 4, 2002. An unsigned copy of the Demand is attached hereto as Exhibit B, and the PCT Notification of Receipt of Demand by Competent International Preliminary Examining Authority is attached hereto as Exhibit C.

On January 21, 2002, applicant's representatives in Australia, F B Rice & Company, Carlton, Victoria, Australia, sent a letter to Morrison & Foerster LLP, Palo Alto, California, a copy of which is attached hereto as Exhibit D, authorizing the filing of a national phase application in the United States of PCT/AU00/00932 by the deadline of February 4, 2002. On February 4, 2002, the present application was filed by Morrison & Foerster. However, instead of filing it as a national phase application under 35 U.S.C. 371, it was filed using the form PTO/SB/05 "Utility Patent Application Transmittal", which is only used for filing applications under 35 U.S.C. 111. The application was filed without declaration, but with an application data sheet containing no "continuity information", but designating as "prior foreign applications" both PCT/AU00/00932 and Australian application PQ2014.

On March 21, 2003, the file of the above-identified application was transferred to the care of Browdy and Neimark,

PLLC. Upon receipt, the application was reviewed and the anomaly with respect to benefit claim was noticed.

The present petition is being promptly filed after noticing this anomaly.

POINTS TO BE REVIEWED AND ACTION REQUESTED

It is requested that the appropriateness of this petition under 37 C.F.R. §1.182 be reviewed. It is further requested that upon granting of this petition, the present application be converted from one having been filed under 35 U.S.C. 111 to one filed under 35 U.S.C. 371, and that the application as filed on February 4, 2002, be considered as having been filed *ab initio* under 35 U.S.C. 371. It is further requested that, upon granting of this petition, the present application be withdrawn from publication as the international filing date will be prior to November 29, 2000.

ARGUMENTS IN SUPPORT OF REQUESTED ACTION

The Present Petition is Appropriate under 37 C.F.R. §1.182

MPEP §1002.02(p) lists petitions and matters decided by the PCT Legal Administrator. Paragraph 5 of this section states:

5. Petitions under 37 C.F.R. 1.182 to convert a national application which was filed under 35 U.S.C. 371 to an application filed under 35 U.S.C. 111(a), or to convert a national application which was filed under 35 U.S.C. 111(a), to an application filed under 35 U.S.C. 371.

It is thus clear that petitions such as the present are contemplated by the Patent and Trademark Office, and the PCT Legal Administrator has been designated as the appropriate individual to decide such a petition. Furthermore, this section of the MPEP provides that such a petition is appropriately filed under 35 C.F.R. §1.182. This rule permits petitions in situations not specifically provided for in the regulations, and states that such situations will be decided in accordance with the merits of each situation by or under the authority of the Commissioner, subject to such other requirements as may be imposed. Thus, it is apparent from MPEP §1002.02(p) that this is not a matter that requires suspension of the rules, which would require a petition under 37 C.F.R. §1.183, but can be decided by simply showing that the situation merits such relief.

Attached hereto is the petition fee of \$130.00 pursuant to 37 C.F.R. §1.17(h).

The Situation Merits the Requested Relief

It is apparent from the evidence submitted herewith that applicant always intended that the present application be filed as a national phase application under 35 U.S.C. 371. The Australian associate assumed that the U.S. associate would do this in the appropriate manner under U.S. law. Clearly, the U.S. associate erred in filing the application the way

they did. Priority cannot be claimed under 35 U.S.C. 119 to an application filed more than 12 months prior to the filing of the U.S. application. The application could have been filed under 35 U.S.C. 120, claiming that the U.S. application was a continuation of the PCT application, but this was not done either.

Converting the present application from an application under 35 U.S.C. 111(a) to one under 35 U.S.C. 371 will correct the error of the former U.S. associate and satisfy the original intent of the applicant.

If this petition is granted, then the present application will be the national phase of an international application filed on August 4, 2000. As this filing date is prior to November 29, 2000, the new amendments to the rules promulgated pursuant to the 18-month publication statute, such as the changes to 37 C.F.R. §1.78(a)(3), are not applicable to this case. There is no deadline for requesting benefit of a prior application for 35 U.S.C. 371 applications based on an international application filed prior to November 29, 2000.

Granting of this petition will not disadvantage the public, as the present application has not yet been published, and if the petition is granted, then it will not be published in view of the filing date of the international application. Granting of this petition will merely correct the error of the original U.S. attorneys filing this case, and put the

application in the position that it was intended to be in without any disadvantage to the public and without contravening of any regulation or statute.

Submitted herewith is a transmittal letter requesting that the present application be considered a 35 U.S.C. 371 application, and pointing out that the specification, claims and drawings as originally filed on February 4, 2002, are an exact copy of the international application specification, claims and drawings, and authorizing that the difference in fees be charged to the deposit account of the undersigned. Also attached is an Application Data Sheet correctly showing applicant's claim for benefit to the PCT application in the Australian priority.

CONCLUSION

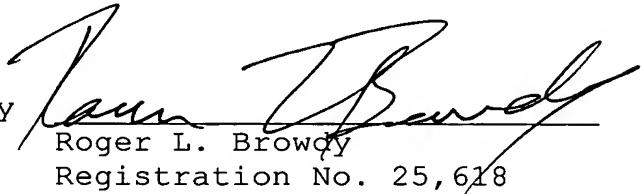
Accordingly, granting of this petition and conversion of the present application from an application under 35 U.S.C. 111(a) to one under 35 U.S.C. 371, based on the information in the attached transmittal letter and correction of the records of the Patent and Trademark Office to show that applicant is entitled to claim the benefit of the international application under 35 U.S.C. 371 and the Australian application under 35 U.S.C. 119, is earnestly solicited. Once granted, it is requested that the application

be withdrawn from the publication process as the international filing date of the application if prior to November 29, 2000.

Respectfully submitted,

BROWDY AND NEIMARK, P.L.L.C.
Attorneys for Applicant(s)

By



Roger L. Browdy
Registration No. 25,618

RLB:ma

Telephone No.: (202) 628-5197

Facsimile No.: (202) 737-3528

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EXHIBIT A

(12) INTERNATIONAL APPLICATION PUBLISHED UNDER THE PATENT COOPERATION TREATY (PCT)

(19) World Intellectual Property Organization
International Bureau



(43) International Publication Date
15 February 2001 (15.02.2001)

PCT

(10) International Publication Number
WO 01/11023 A1

(51) International Patent Classification⁷: C12N 9/00,
A61K 38/43, C12Q 1/68

New York, NY 10023 (US). CAIRNS, Murray, John
[AU/AU]; 17 Alpha Road, Woy Woy, NSW 2256 (AU).

(21) International Application Number: PCT/AU00/00932

(74) Agent: F.B.RICE & CO.; 139 Rathdowne Street, Carlton,
VIC 3053 (AU).

(22) International Filing Date: 4 August 2000 (04.08.2000)

(25) Filing Language: English

(81) Designated States (national): AE, AG, AL, AM, AT, AU,
AZ, BA, BB, BG, BR, BY, BZ, CA, CH, CN, CR, CU, CZ,
DE, DK, DM, DZ, EE, ES, FI, GB, GD, GE, GH, GM, HR,
HU, ID, IL, IN, IS, JP, KE, KG, KP, KR, KZ, LC, LK, LR,
LS, LT, LU, LV, MA, MD, MG, MK, MN, MW, MX, NO,
NZ, PL, PT, RO, RU, SD, SE, SG, SI, SK, SL, TJ, TM, TR,
TT, TZ, UA, UG, US, UZ, VN, YU, ZA, ZW.

(30) Priority Data:
PQ 2014 4 August 1999 (04.08.1999) AU

(84) Designated States (regional): ARIPO patent (GH, GM,
KE, LS, MW, MZ, SD, SL, SZ, TZ, UG, ZW), Eurasian
patent (AM, AZ, BY, KG, KZ, MD, RU, TJ, TM), European
patent (AT, BE, CH, CY, DE, DK, ES, FI, FR, GB, GR, IE,
IT, LU, MC, NL, PT, SE), OAPI patent (BF, BJ, CF, CG,
CI, CM, GA, GN, GW, ML, MR, NE, SN, TD, TG).

(72) Inventors; and

Published:

(75) Inventors/Applicants (for US only): HANDEL, Malcolm,
Lovell [AU/AU]; 3 Newark Crescent, Lindfield,
NSW 2070 (AU). NGUYEN, Ly, Quoc, Quynh [AU/AU];
5/10 Kynaston Avenue, Randwick, NSW 2031 (AU).
ATKINS, David G. [AU/US]; 45w 60th St., Apt 17A,

— With international search report.

For two-letter codes and other abbreviations, refer to the "Guidance Notes on Codes and Abbreviations" appearing at the beginning of each regular issue of the PCT Gazette.

WO 01/11023 A1

(54) Title: TREATMENT OF INFLAMMATORY OR MALIGNANT DISEASE USING DNAZYMES

(57) Abstract: The present invention relates to DNAzymes which are targeted against mRNA molecules encoding RelA(p65) (a subunit of NF- κ B). The present invention also relates to compositions including these DNAzymes and to methods of treatment involving administration of the DNAzymes.

The demand must be filed directly in the competent International Preliminary Examining Authority or, if two or more Authorities are listed below:
IPEA/

EXHIBIT B

PCT

CHAPTER II

DEMAND

under Article 31 of the Patent Cooperation Treaty:
The undersigned requests that the International application specified below be the subject of international preliminary examination according to the Patent Cooperation Treaty and hereby elects all eligible States (except where otherwise indicated).

For International Preliminary Examining Authority use only

Identification of IPEA

Date of receipt of DEMAND

Box No. I IDENTIFICATION OF THE INTERNATIONAL APPLICATION		Applicant's or agent's file reference 92727
International application No. PCT/AU00/00932	International filing date (day/month/year) 04 August 2000 (04/08/00)	(Earliest) Priority date (day/month/year) 04 August 1999 (04/08/99)

Title of invention

TREATMENT OF INFLAMMATORY AND MALIGNANT DISEASES

Box No. II APPLICANT(S)

Name and address: (Family name followed by given name; for a legal entity, full official designation. The address must include postal code and name of country.) Johnson & Johnson Research Pty Ltd Level 4, 1 Central Avenue Australian Technology Park Eveleigh, New South Wales 1430 AUSTRALIA	Telephone No. Facsimile No. Teleprinter No.
--	---

State (that is, country) of nationality:

AU

State (that is, country) of residence:

AU

Name and address: (Family name followed by given name; for a legal entity, full official designation. The address must include postal code and name of country.) Unisearch Limited Gate 14 Barker Street UNSW Sydney, New South Wales 2052 AUSTRALIA

State (that is, country) of nationality:

AU

State (that is, country) of residence:

AU

Name and address: (Family name followed by given name; for a legal entity, full official designation. The address must include postal code and name of country.) HANDEL, Malcolm Lovell 3 Newark Crescent Lindfield New South Wales 2070 AUSTRALIA
--

State (that is, country) of nationality:

AU

State (that is, country) of residence:

AU

Further applicants are indicated on a continuation sheet

Sheet No. 2

International application No.

PCT/AU00/00832

Continuation of Box No. II APPLICANT(S)

If none of the following sub-boxes is used, this sheet is not to be included in the demand.

Name and address: (Family name followed by given name; for a legal entity, full official designation. The address must include postal code and name of country.)

NGUYEN, Ly Quoc Quynh
 5/10 Kynaston Avenue
 Randwick New South Wales 2031
 AUSTRALIA

State (that is, country) of nationality:

AU

State (that is, country) of residence:

AU

Name and address: (Family name followed by given name; for a legal entity, full official designation. The address must include postal code and name of country.)

ATKINS, David G.
 45W 60th St, Apt 17A
 New York New York 10023
 UNITED STATES OF AMERICA

State (that is, country) of nationality:

AU

State (that is, country) of residence:

US

Name and address: (Family name followed by given name; for a legal entity, full official designation. The address must include postal code and name of country.)

CAIRNS, Murray John
 17 Alpha Road
 Woy Woy New South Wales 2256
 AUSTRALIA

State (that is, country) of nationality:

AU

State (that is, country) of residence:

AU

Name and address: (Family name followed by given name; for a legal entity, full official designation. The address must include postal code and name of country.)

State (that is, country) of nationality:

State (that is, country) of residence:

Further applicants are indicated on another continuation sheet.

Sheet No. 3

International application No.

PCT/AU00/00932

Box No. III AGENT OR COMMON REPRESENTATIVE; OR ADDRESS FOR CORRESPONDENCE

The following person is agent common representative
 and has been appointed earlier and represents the applicant(s) also for international preliminary examination.
 is hereby appointed and any earlier appointment of (an) agent(s)/common representative is hereby revoked.
 is hereby appointed, specifically for the procedure before the International Preliminary Examining Authority, in addition to the agent(s)/common representative appointed earlier.

Name and address: (family name followed by given name; for a legal entity, full official designation.
 The address must include postal code and name of country.)

F B RICE & CO
 139 Rathdowne Street
 CARLTON VIC 3053
 AUSTRALIA

Telephone No

(613) 9655 4400

Facsimile No.

(613) 9663 3099

Telex/printer No.

Address for correspondence: Mark this check-box where no agent or common representative is/has been appointed and the space above is used instead to indicate a special address to which correspondence should be sent.

Box No. IV BASIS FOR INTERNATIONAL PRELIMINARY EXAMINATIONStatement concerning amendments:¹

1. The applicant wishes the international preliminary examination to start on the basis of:
 the international application as originally filed

the description as originally filed
 as amended under Article 34

the claims as originally filed
 as amended under Article 19 (together with any accompanying statement)
 as amended under Article 34

the drawings as originally filed
 as amended under Article 34

2. The applicant wishes any amendment to the claims under Article 19 to be considered as reversed.

3. The applicant wishes the start of the international preliminary examination to be postponed until the expiration of 20 months from the priority date unless the International Preliminary Examining Authority receives a copy of any amendments made under Article 19 or a notice from the applicant that he does not wish to make such amendments (Rule 69.1(d)). (This check-box may be marked only where the time limit under Article 19 has not yet expired).

- * Where no check-box is marked, international preliminary examination will start on the basis of the international application as originally filed or, where a copy of amendments to the claims under Article 19 and/or amendments of the international application under Article 34 are received by the International Preliminary Examining Authority before it has begun to draw up a written opinion or the international preliminary examination report, as so amended.

Language for the purposes of international preliminary examination:

- which is the language in which the international application was filed.
- which is the language of a translation furnished for the purposes of international search.
- which is the language of publication of the international application.
- which is the language of the translation (to be) furnished for the purposes of international preliminary examination.

Box No. V ELECTION OF STATES

The applicant hereby elects all eligible States (that is, all States which have been designated and which are bound by Chapter II of the PCT) excluding the following States which the applicant wishes not to elect:

Sheet No. 4

International application No.

PCT/AU00/00932

Box No. VI CHECKLIST

The demand is accompanied by the following elements, in the language referred to in Box No. IV, for the purposes of international preliminary examination:

- | | | |
|---|---|--------|
| 1. translation of international application | : | sheets |
| 2. amendments under Article 34 | : | sheets |
| 3. copy of (or, where required, translation) of amendments under Article 19 | : | sheets |
| 4. copy of (or, where required, translation) of statement under Article 19 | : | sheets |
| 5. letter | : | sheets |
| 6. other (specify) | : | sheets |

For International Preliminary Examining Authority use only
received not received

<input type="checkbox"/>	<input type="checkbox"/>

The demand is also accompanied by the item(s) marked below:

- | | |
|---|---|
| 1. <input checked="" type="checkbox"/> fee calculation sheet | 4. <input type="checkbox"/> statement explaining lack of signature |
| 2. <input type="checkbox"/> separate signed power of attorney | 5. <input type="checkbox"/> nucleotide and or amino acid sequence listing in computer readable form |
| 3. <input type="checkbox"/> copy of general power of attorney; reference number, if any | 6. <input type="checkbox"/> other (specify) |

Box No. VII SIGNATURE OF APPLICANT, AGENT OR COMMON REPRESENTATIVE

Next to each signature, indicate the name of the person signing and the capacity in which the person signs (if such capacity is not obvious from reading the demand).

JENNY PETERING
for and on behalf of F B Rice & Co

For International Preliminary Examining Authority use only

1. Date of actual receipt of DEMAND:
2. Adjusted date of receipt of demand due to CORRECTIONS under Rule 60.1(b):
3. The date of receipt of the demand is AFTER the expiration of 19 months from the priority date and item 4 or 5, below, does not apply. The applicant has been informed accordingly.
4. The date of receipt of the demand is WITHIN the period of 19 months from the priority date as extended by virtue of Rule 80.5
5. Although the date of receipt of the demand is after the expiration of 19 months from the priority date, the delay in arrival is EXCUSED pursuant to Rule 82.

For International Bureau use only

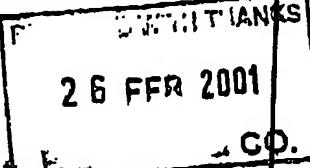
Demand received from IPRA on:

Form PCT/IPRA/401 (last sheet)(July 1998)

See Notes to the demand form

PATENT COOPERATION TREATY

From the
INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY

To: Agent :	F. B. RICE & CO. 139 Rathdowne Street CARLTON VIC 3053
 26 FEB 2001	

**NOTIFICATION OF RECEIPT
OF DEMAND BY COMPETENT INTERNATIONAL
PRELIMINARY EXAMINING AUTHORITY**

(PCT Rule 59.3(e) and 61.1(b), first sentence
and Administrative Instructions, Section 601(a))

Date of mailing
(day/month/year) **23 FEB 2001**
 (23/2/01)

Applicant's or agent's file reference. 92727	IMPORTANT NOTIFICATION	
International application No. PCT/AU00/00932	International filing date (day/month/year) 4 AUG 2000 (4/8/00)	Priority date (day/month/year) 4 AUG 1999 (4/8/99)
Applicant Johnson & Johnson Research Pty Ltd (et al.)		

1. The applicant is hereby notified that this International Preliminary Examining Authority considers the following date as the date of receipt of the demand for international preliminary examination of the international application:

19 FEB 2001 (19/2/01)

2. That date of receipt is:

- the actual date of receipt of the demand by this Authority (Rule 61.1(b)).
- the actual date of receipt of the demand on behalf of this Authority (Rule 59.3(e)).
- the date on which this Authority has, in response to the Invitation to correct defects in the demand (Form PCT/IPEA/404), received the required corrections.

3. **Attention:** That date of receipt is AFTER the expiration of 19 months from the priority date. Consequently, the elections(s) made in the demand does (do) not have the effect of postponing the entry into the national phase until 30 months from the priority date (or later in some Offices) (Article 39(1)). Therefore, the acts for entry into the national phase must be performed within 20 months from the priority date (or later in some Offices) (Article 22). For details, see the *PCT Applicant's Guide, Volume II*.

- (If applicable) This notification confirms the information given by telephone, facsimile transmission or in person on:

4. Only where paragraph 3 applies, a copy of this notification has been sent to the International Bureau.

Name and mailing address of the IPEA/AU
AUSTRALIAN PATENT OFFICE
PO BOX 200, WODEN ACT 2606, AUSTRALIA
E-mail: pct@ipaustralia.gov.au
Facsimile No. 02 6285 3929

Authorized officer

JOHN COLDWELL
02 6283 7924

Telephone No.

EXHIBIT D

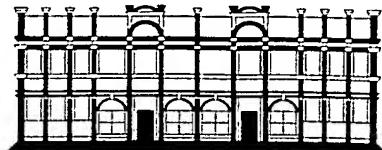
By courier
PLEASE ACKNOWLEDGE RECEIPT BY FACSIMILE

Our Ref: 500239

21 January 2002

Morrison & Foerster LLP
755 Page Mill Road
Palo Alto CA 94304-1018
United States Of America

RECEIVED
JAN 24 2002
Morrison & Foerster, LLP
Palo Alto



F B RICE & CO
Patent and Trade Mark Attorneys

Unisearch Limited, Johnson & Johnson Research Pty Ltd
International Patent Application No PCT/AU00/00932
Entitled: "Treatment of inflammatory and malignant diseases"
Commencement of National Phase in The United States of
America
DUE DATE: 4 FEBRUARY 2002

Dear Sirs

Please file the necessary documents in order to commence the above National Phase and to act as agent in the prosecution of the application.

On the enclosed sheet you will find details of the required particulars and enclosures included with this letter.

The claims include improper multiple dependencies for the United States. Please prepare a Preliminary Amendment to replace the improper multiple dependent claims to reduce the filing costs.

Please advise if you require any additional information to enter this National Phase and supply us with any documents, not listed on the attached sheet, that are required for execution. Thank you for your assistance in this matter.

Kindly advise us when the first renewal is payable or, if you pay a renewal fee at the time of filing, when the next renewal fee is payable. Our client's renewal payment service will then be responsible for renewals.

Yours faithfully
F B RICE & CO

Jenny Petering
JENNY PETERING

JEP/rcn/a21/pal050us
Encls

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ASSOCIATES:
Gwen Bentley BSc FIPTA
Will Monks BE (Hons) MLS
Ian J Rourke BSc (Hons) PhD
* Trade Mark attorney

F B RICE & CO also has a Sydney Office

F B RICE & CO is associated with
Computer Patent Annuites (CPA)

PARTICULARS FOR ENTRY INTO NATIONAL PHASE via Chapter II

Country	United States of America	DUE DATE 4 FEBRUARY 2002		
Title	Treatment of inflammatory and malignant diseases			
Our Reference	500239			
Applicant(s)/ Inventor(s)	HANDEL, Malcolm, Lovell [AU/AU]; 3 Newark Crescent, Lindfield, New South Wales, 2070, Australia; NGUYEN, Ly, Quoc, Quynh [AU/AU]; 5/10 Kynaston Avenue, Randwick, New South Wales, 2031, Australia; ATKINS, David, G. [AU/US]; 45w 60th St., Apt 17A, New York, NY 10023, United States of America; CAIRNS, Murray, John [AU/AU]; 17 Alpha Road, Woy Woy, New South Wales, 2256, Australia.			
Assignee	JOHNSON & JOHNSON RESEARCH PTY LTD, [AU/AU]; A.C.N. 003 328 176, of Australian Technology Park, Level 4, 1 Central Avenue, Eveleigh, New South Wales, 1430, Australia; UNISEARCH LIMITED, [AU/AU]; A.C.N. 000 263 025, of Rupert Myers Building, Level 2, Gate 14, Barker Street, UNSW, Sydney, New South Wales, 2052, Australia.			
Priority:	Application No	Country	Country Code	Date of Application
	PQ2014	Australia	AU	4 August 1999
	Applicant	UNISEARCH LIMITED		
International Application	Application No	PCT/AU00/00932	Publication No.	WO 01/11023
	Filing Date	4 August 2000	Publication Date	15 February 2001
Demand Filed	Demand for International Preliminary Examination Filed 19 February 2001			
Documents	<u>Enclosed are the following:-</u> <ul style="list-style-type: none"> • Specification published with International Search Report • International Preliminary Examination Report • Copies of prior art cited in the International Search Report • PCT Request • Diskette containing specification sequence listing 			
	<u>To follow:-</u> <ul style="list-style-type: none"> • Assignment • Combined Declaration and Power of Attorney 			
Entity Status	Large Entity			
Renewals	Renewals will be handled by our client's renewal payment service.			